



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,139	05/23/2000	Paul Lapstun	NPA019US	9190

24011 7590 02/05/2003

SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT PAPER NUMBER

2622

DATE MAILED: 02/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/575,139

Applicant(s)

LAPSTUN ET AL.

Examiner

Madeleine AV Nguyen

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 25-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 25, 2002 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 25, 28-30, 32-33, 36-37, 39, 41-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Merchant et al (US Patent No. 5,581,366).

Concerning claim 25 and 36, Merchant discloses a system and method (Fig.1) of enable a user to compose and deliver a message by facsimile, utilizing a form printed onto at least one surface, the form including information relating to the user and at least one area for the user to enter the message, the at least one surface having coded data indicative of an identity of the form and of the at least one area (Figs.2, 4, 6), comprising means for and steps of providing the form to the user (Figs.2, 6); receiving, in a computer system, interaction data from a sensing device

Art Unit: 2622

used to compose the message (50, Fig.3), the interaction data being indicative of an identity of the form and a position of the sensing device relative to the are, the sensing device, when placed operatively relative to the area in order to compose the message (Figs.2, 6), generating the interaction data based at least partially on sensing at least some of the coded data in the vicinity of the position; capturing electronically, in the computer system and from the interaction data, at least the message; and transmitting the message to a designated recipient address for facsimile delivery (Fig.7; Abstract; col. 2, line 58 – col. 5, line 47; col. 6, lines 6-32) .

Concerning claims 28-30-32-33, 37, 39, 41-45, the message is delivered with a reply number for sending a return message, the sender indicates on the form, whether a reply number is to be transmitted with the message; the recipient address is entered on the form in writing, using the sensing device, and the writing is electronically captured and converted into digital form to facilitate transmission of the message; receiving movement data regarding movement of the sensing device relative to the form; the sensing device generates the movement data using at least some of the coded data; the sensing device includes a marking nib (Figs.1-4, 6-7; col. 2, line 58 – col. 5, line 47; col. 6, lines 6-32).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2622

5. Claims 26-27, 34, 38, 46, 48, 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merchant et al as applied to claims 25, 36 above, and further in view of Tanaka (US Patent No. 4,494,862).

Concerning claims 26-27, 38, 48, 49, Merchant fails to teach that the form is printed, the form and the coded data to be printed simultaneously, a binding means for binding the printed form in the event the form includes a plurality of pages. However, it was commonly known in the art that a conventional facsimile machine can print fax message and a facsimile with a printer can have a binding means for binding the printed form. Tanaka support that well known in the prior art by disclosing a computerizing information processing system capable of printing a form with coded data input from stylus simultaneously (Figs. 9, 10), and the system in Tanaka can print a plurality of copies wherein binding can be performed. It would have been obvious to one skilled in the art at the time the invention was made to combine the teaching of printing a form with stylus input information simultaneously and the binding of a plurality of pages in Tanaka to the system in Merchant since the system in Merchant is a facsimile machine which can transmit and receive fax message wherein it was commonly known in the art that the received message can be printed.

Concerning claims 34, 46, Merchant fails to teach that the coded data is substantially invisible to the average unaided human eye. Tanaka further teaches that the stylus input device is a marking fluorescent pen which is invisible to the average unaided human eye and wherein marking marks from the fluorescent pen are detected by color mark sensor 22 (col. 9, lines 25-36; col. 12, lines 56-60). It would have been obvious to one skilled in the art at the time the invention was made to combine the teaching of using fluorescent pen for invisible coded data in

Art Unit: 2622

Tanaka to the system in Merchant since Merchant also teach the use of a pen for generating coded data for fax message.

6. Claim 31, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merchant.

Concerning claim 31, 35, Merchant does not directly teach that the recipient address is selected from a document provided with an address list, and the system and method includes retaining a retrievable record of each form printed using at least some of the coded data on the surface on which the form is printed. However, it was commonly known in the art that the recipient address is selected from an address list and the form is stored in a memory for retrieval. Merchant teaches an address memory (72, Fig.3) for storing a plurality of addresses or a list of addresses, and an image memory (16, Fig.1) for storing the form to be used. It would have been obvious to one skilled in the art at the time the invention was made to consider that the address memory 72 in Merchant stores a list of address wherein an address can be selected, and the image memory 16 in Merchant stores the fax form to be retrieved as a matter of well known in the prior art.

7. Claims 40, 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merchant as applied to claims 25, 36 above, and further in view of Baran (US Patent No. 5,247,591).

Concerning claims 40, 47, Merchant fails to teach that the fax message is transmitted to a fax server and the system includes a database for keeping a retrievable record of each form printed. Baran discloses a method and apparatus for routing fax messages using hand printed characters to a fax server (Fig.8; 208, Fig.10) including a database (196, Fig.8). It would have

Art Unit: 2622

been obvious to one skilled in the art at the time the invention was made to combine the teaching of transmission to and reception of fax message from a fax server and a database for keeping retrieval record in Baran to the system in Merchant since both Merchant and Baran teach fax device which can transmit a sheet form with information relating the routing of the fax message and handwritten information on the form as a fax message to remote fax machines.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Boyer (US Patent No. 5,459,796) discloses a system for entering handwritten data into computer generated forms.
- b. Johnson (US Patent No. 5,060,980) teaches a form utilizing encoded indications for form filled processing.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.

Application/Control Number: 09/575,139

Art Unit: 2622

Page 7

A handwritten signature in black ink, appearing to read "Madeleine AV Nguyen". The signature is fluid and cursive, with the first name "Madeleine" and the last name "Nguyen" being more prominent than the middle initials "AV".

AV

January 30, 2003

Madeleine AV Nguyen

Primary Examiner

Art Unit 2622